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09/710,966	11/14/2000	Scott D. Landes	5482	6125

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EXAMINER

COURSON, TANIA C

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,966

Applicant(s)

LANDES, SCOTT D.

Examiner

Tania C. Courson

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution After Appeal

1. In view of the appeal brief filed on June 28, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.
2. To avoid abandonment of the application, appellant must exercise one of the following two options:
 - a. file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
 - b. request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131, or 1.132) or other evidence are permitted. See 37 CFR 1.193 (b)(2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2859

4. Claims 1, 3-5, 7 and 11 are rejected under 35 U.S.C. 103(a) as being anticipated by Ronden (US 4,078,867) in view of Humphrey et al. (US 4,084,914).

Ronden discloses in Figures 1-5, an marker post comprising:

With respect to claim 1:

a) a hollow elongated member (Fig. 1, marker post 1) said elongated member composed of a flexibly resilient polymer plastic (column 2, lines 50-53), said elongated member having a first end (Fig. 1 and column 3, lines 64-66) and a second end (Fig. 1 and column 3, lines 64-66);

With respect to claim 3:

a) wherein said polymer plastic is polycarbonate or polyethylene (column 2, lines 50-53);

With respect to claim 4:

a) wherein said elongated member is triangular, circular, rectangular or square shaped (Figs. 1-2) and said elongated member includes a non-tapered exterior surface (Figs. 1-2).

With respect to claims 5 and 11:

a) wherein said elongated member is weather resistant (column 2, lines 50-53);

Art Unit: 2859

With respect to claims 7:

a) wherein said elongated member is stiff (Fig. 1).

Ronden does not disclose an integral anchoring flap, said anchoring flap having a first end and a second end, said anchoring flap located proximate a second end of an elongated member; and a flexible living hinge, said anchoring flap attached to the elongated member at the second end of said anchoring flap by said flexible living hinge, said anchoring flap moveable from a first closed position to a second open position, wherein said anchoring flap is weather resistant and is in a coplanar condition with a marker post when said anchoring flap is in a closed position.

With respect to claims 1 and 7: With respect to the intended use of the apparatus, e.g. to facilitate handling and transportation of said marker post, to prevent withdrawal of said elongated member from an embedded position, and to permit the marker post to be driven into a top layer of soil: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

With respect to claim 7: The recitation that an element is “sufficient”, to perform a given function is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense.

With respect to an integral anchoring flap, said anchoring flap having a first end and a second end, said anchoring flap located proximate a second end of an elongated member; and a flexible living hinge, said anchoring flap attached to the elongated member at the second end of said anchoring flap by said flexible living hinge, said anchoring flap moveable from a first closed position to a second open position, wherein said anchoring flap is weather resistant and is in a coplanar condition with a marker post when said anchoring flap is in a closed position, Humphrey et al. teach a guide post that consists of an integral anchoring flap (Fig. 6, barbs 86), said anchoring flap having a first end and a second end (Fig. 6), said anchoring flap located proximate a second end of an elongated member (Fig. 6); and a flexible living hinge (Fig. 7), said anchoring flap attached to the elongated member at the second end of said anchoring flap by said flexible living hinge (Fig. 7), said anchoring flap moveable from a first closed position to a second open position (column 4, lines 52-56), wherein said anchoring flap is weather resistant (column 1, line 65) and is in a coplanar condition with a marker post when said anchoring flap is in a closed position (column 4, lines 52-56). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the marker post of Ronden, so as to include an integral anchoring flap with a flexible living hinge, as taught by Humphrey et al., so as to provide a means for inhibiting removal of the post (column 4, lines 52-54).

5. Claims 2, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ronden and Humphrey et al., as applied to claims 1, 3-5, 7 and 11 as stated above, and further in view of Stuart (US 6,461,084) and Arthur (US 4,522,530).

Ronden and Humphrey et al. disclose a marker post as stated above in paragraph 4.

They do not disclose a second and a third integral anchoring flap having a second and a third flexible living hinge, said integral anchoring flaps circumferentially positioned around an elongated member and including a weather resistant cap.

With respect to a second and a third integral anchoring flap having a second and a third flexible living hinge and said integral anchoring flaps circumferentially positioned around an elongated member, Stuart teaches a post that consists of a second and a third integral anchoring flap having a second and a third flexible living hinge (Fig. 1) and said integral anchoring flaps circumferentially positioned around an elongated member (Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the post of Ronden and Humphrey et al., so as to include a second and a third integral anchoring flap having a second and a third flexible living hinge and said integral anchoring flaps circumferentially positioned around an elongated member, as taught by Stuart, so as to enhance the engagement of the post to the ground (column 3, lines 39-40).

With respect to including a weather resistant cap, Arthur teaches a marking post that consists of including a weather resistant cap (Fig. 6, closure 84). Therefore, it would have been

Art Unit: 2859

obvious to one having ordinary skill in the art at the time the invention was made to further modify the marker post of Ronden and Humphrey et al., so as to include a weather resistant cap, as taught by Arthur, so as to provide a means of preventing an accumulation of water and debris with the post (column 3, lines 60-64).

With respect to claims 2, 6 and 12: With respect to the intended use of the apparatus, e.g. to facilitate handling and transportation of said marker post, to prevent withdrawal of said elongated member from an embedded position, for covering the first end of said elongated member, to prevent rain or snow from entering the elongated member: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

6. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being anticipated by Cornou (US 4,249,357) in view of Stuart (US 6,461,084).

Cornou discloses in Figures 1 and 7, a road marker comprising:

With respect to claim 8:

a) a triangular shaped elongated member (Fig. 7) having a first panel, a second panel, and a third panel forming the elongated member (Fig. 7), said elongated member composed of a flexibly resilient polymer plastic (column 2, lines 63-66) and said triangular shaped elongated member having a first open end and a second open end (Fig. 7);

With respect to claim 9:

- a) wherein said polymer plastic is polycarbonate or polyethylene (column 2, lines 63-66);

With respect to claims 10:

- a) wherein said elongated member is stiff (Fig. 7).

Cornou does not disclose a first anchoring flap, a second anchoring flap, and a third anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps integrally connected to said elongated member, each of said anchoring flaps located proximate a second end of said elongated member, a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge, the second end of said first anchoring flap attached to the first panel of said elongated member by said first flexible living hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second flexible living hinge, the second end of said third anchoring flap attached to the third panel of said elongated member by said third flexible living hinge, each of said anchoring flaps moveable from a first closed position to a second open position.

With respect to a first anchoring flap, a second anchoring flap, and a third anchoring flap, each of said anchoring flaps having a first end and a second end, each of said anchoring flaps integrally connected to said elongated member, each of said anchoring flaps located proximate a

Art Unit: 2859

second end of said elongated member, a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge, the second end of said first anchoring flap attached to the first panel of said elongated member by said first flexible living hinge, the second end of said second anchoring flap attached to the second panel of said elongated member by said second flexible living hinge, the second end of said third anchoring flap attached to the third panel of said elongated member by said third flexible living hinge, each of said anchoring flaps moveable from a first closed position to a second open position, Stuart teaches a post that consists of a first anchoring flap, a second anchoring flap, and a third anchoring flap (Fig. 1), each of said anchoring flaps having a first end and a second end (Fig. 4), each of said anchoring flaps integrally connected to said elongated member (Fig. 4), each of said anchoring flaps located proximate a second end of said elongated member (Fig. 1), a first flexible living hinge, a second flexible living hinge, and a third flexible living hinge (Fig. 1), the second end of said first anchoring flap attached to the first panel of said elongated member by said first flexible living hinge (Fig. 1), the second end of said second anchoring flap attached to the second panel of said elongated member by said second flexible living hinge (Fig. 1), the second end of said third anchoring flap attached to the third panel of said elongated member by said third flexible living hinge (Fig. 1), each of said anchoring flaps moveable from a first closed position to a second open position (column 3, lines 37-40). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the post of Cornou, so as to include integral anchoring flaps with flexible living hinges attached to a panel, as taught by Stuart, so as to enhance the engagement of the post to the ground (column 3, lines 39-40).

Art Unit: 2859

With respect to claim 8: It has been held that the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish. *In re Mason*, 114 USPQ 127, 44 CCPA 937 (1957).

With respect to claims 8 and 10: With respect to the intended use of the apparatus, e.g to facilitate handling and transportation of said marker post, to prevent withdrawal of said elongated member from an embedded position, to permit the marker post to be driven into a top layer of soil: It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

With respect to claims 8 and 10: The recitation that an element is “sufficient”, to perform a given function is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2859

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3, 6, 7 and 12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,099,203 in view of Humphrey et al (US 4,084,914).

9. Claims 8-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,099,203 in view of Humphrey et al (US 4,084,914).

Response to Arguments

10. Applicant's arguments filed on July 28, 2003 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art cited on PTO-892 and not mentioned above disclose a marker post:

Art Unit: 2859

Joyner, III et al. (US 6,113,307)

Ryan (US 4,123,183)

Mizouchi (Translated version, JP-57067817 A)

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tania C. Courson whose telephone number is (703) 305-3031.

The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax number for this Organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DIEGO F.F. GUTIERREZ
SUPERVISORY PATENT EXAMINER
GROUP ART UNIT 2859

TCC
October 10, 2003